

### **Remarks re: Amendments to the Claims**

#### **Amendments to Pending Claims**

Independent pending claims 1, 31, and 32, have been amended to better define the invention by adding to each of these claims, where not already included, three functional limitations requiring that the safety stopper be sized and shaped “such that the safety stopper, when attached to the striker, defines a clear path for movement of the strike plate with respect to the flint”, “such that the safety stopper allows manual operation of the striker while the safety stopper is attached to the striker”, and “such that the safety stopper reduces the chances of the operator being thrown off balance by the striker catching on an external object when the striker, with the safety stopper attached, is carried hands-free attached to an operator’s belt”. These phrases find support in the application as filed, under Summary of the Invention, at paragraph [0005], and as illustrated in FIGS. 1-2, 5 and 18-34.

Claim 31 is further amended to better define the invention by adding the phrase “safety stopper adapted for attachment to the striker”. This phrase finds support in the application as filed, under Summary of the Invention, at paragraph [0005], third and fifth sentences; at paragraph [0009], second sentence; at paragraph [0012]; at paragraph [0024]; and in the body of claim 19 as originally filed.

Claim 31 is further amended to explicitly define the scope and unity of the invention of claim 31, a unity that is inherent in the application as filed, and is now explicit in claim 31 as currently amended. To this end, claim 31 is amended to define the safety stopper as “including a cover, wherein said cover is a structure selected from the group consisting of a sleeve, a sock, a plate and a molded web”. The sleeve, the sock, the plate and the molded web find support in the application as filed in FIGS. 1, 18, 19, and 33, respectively, with associated description in the specification.

A claim, drafted according to Markush practice, provides an artificial generic expression when a claimed element is specified as including the members of a group “disclosed in the specification to possess at least one property in common which is mainly responsible for their function in the claimed relationship, and it is clear from their very nature or from the prior art

that all of them possess this property". See *Ex Parte Markush*, 1925 CD 126; 340 OG 839, and MPEP 803.02.

In claim 31 as currently amended, the members of the Markush group have "at least one property in common which is mainly responsible for their function in the claimed relationship". The "property" in claim 31 is that they are "shaped to cover a substantial portion of the open area". Their "function" in claim 31 is to ensure "that the safety stopper, when attached to the striker, defines a clear path for movement of the strike plate with respect to the flint", "that the safety stopper allows manual operation of the striker while the safety stopper is attached to the striker", and "that the safety stopper reduces the chances of the operator being thrown off balance by the striker catching on an external object when the striker, with the safety stopper attached, is carried hands-free attached to an operator's belt". Thus, each member of the group constitutes a valid element of a Markush group, and the members of the Markush group are not patentably distinct. Therefore claim 31, as currently amended, is a generic linking claim with respect to all claims directed to a "welding torch striker with safety stopper".

#### **Amendments to Withdrawn Claims under CFR 1.121(c)(2)**

Claim 19 is amended to incorporate the three functional limitations added to claim 31.

Claim 19 is also amended to require that the first arm of the welding torch striker includes a "strike plate", and to require that the second arm includes a "flint". This amendment finds support in the application as filed at paragraph [0004] of the specification as originally filed.

Claim 19 (directed to "safety stopper") is also amended to become not patentably distinct from claim 31 (directed to "welding torch striker with safety stopper") so that claim 19 will become eligible for examination when claim 31 is found allowable.

To this end, claims 19 and 31 are amended so that both claims use the same wording to define "safety stopper". This ensures that the combination of claim 31, as claimed, requires the particulars of the sub-combination of claim 19, as claimed, for patentability, so claims 19 and 31 are not patentably distinct. See 806.05(a): "Combination and Sub-combination". This makes

sub-combination claim 19 eligible for examination when combination claim 31 is found allowable.

The above amendments to claim 19 make claim 21 redundant. Accordingly, independent claim 21 has been canceled. (Claim 20 remains withdrawn).

Independent claims 7 and 10 include points of novelty beyond the limitations of generic linking claim 19. Accordingly, claims 7 and 10 have been converted to dependent form, and have been amended to depend from claim 19.

#### **Amendments to Dependent Claims**

Following cancellation of independent claim 21, dependent claims 22, 27-28 and 30 have been amended to depend from generic linking claim 31. This causes all of dependent claims 22-30 to ultimately depend from generic linking claim 31.

Following conversion of claims 7 and 10 to dependent form, dependent claims 7 and 10 have been amended to depend from generic linking claim 19. This causes all of dependent claims 7-18 to ultimately depend from generic linking claim 19.

Claim 9 has been further amended to add "further comprising a grommet", thereby providing the necessary antecedent for "wherein the grommet" in the body of the claim. The term "a grommet" finds support in the application as filed at paragraph [0067], and "a grommet 72" is shown in FIG. 18.

For the Examiner's convenience, a new Claims/Species Map, characterizing the claims following entry of the above amendments, is presented herewith, as follows.

## CLAIMS/SPECIES MAP

Serial No.: 10/827,140

Docket No. 1430/103

Pending claims 1-37, as currently amended

		Independent Claim No.: Generic Type	1			19 */S	20	21							31 */C	32
		Dependent Claims:	2- 6	7- 9	10- 18	-	-	-	22	23- 25	26	27	28- 29	30	-	33- 37
STATUS		Pe=Pending Wi=Withdrawn Ca=Canceled	Pe	Wi	Wi	Wi	Wi	Ca	Wi	Wi	Wi	Wi	Wi	Wi	Pe	Pe
Claim Type		C = Combination S = Sub- Combination	S	S	S	S	S	C	C	C	C	C	C	C	C	S
		Dependent claim(s) above ultimately depend from	1	19	19	-	-	-	31	31	31	31	31	31	-	32
SPECIES**	FIGS.	Feature														
1	1-2 & 5	Flexible sleeve	√			√	√								√	√
-	3-4 & 6-15	(Prior Art)	-	-	-	-	-		-	-	-	-	-	-	-	-
2	16-17	Flexible sleeve	√			√	√								√	√
3	18	Flexible sock		√		√	√					√			√	
4	19-21	Rigid plate			√	√	√						√		√	
5	22-25	Rigid plate			√	√	√						√		√	
6	26-28	Clamped rigid plates			√	√	√						√	√	√	
7	29-32	Rigid plate			√	√	√						√		√	
8	33-34	Molded web				√	√		√	√					√	√
9	35-36	Pouch on molded web				√	√			√	√				√	√

\*/S or \*/C indicates Generic Linking Claim, Sub-combination (S) or Combination (C).

\*\* indicates species numbers, as defined by Examiner.

√ indicates claim(s) in column read(s) on all FIG(S) in row.

### Response to Rejection of Claims under 35 USC 103(a)

The Examiner rejected claims 1-5, 31, and 32 under 35 U.S.C. 103(a) as being unpatentable over Webb (5,501,382) based on new *prima facie* arguments.

In rejecting claims 1-3, the Examiner argues:

Applicant has admitted a striker as prior art. Webb discloses a universal hand tool holder a sleeve 110 made of "leather" (C: 3, L: 32), means (224A, 2246) for attaching holder to a belt, and "Although the preferred embodiment tool holder 100 is designed to be relatively universal in its application, each of a set of holsters may be customized somewhat to better accommodate a particular tool" (C: 6, L: 8-11). However, Webb does not disclose the tool holder specifically used for a welding torch striker. It is common knowledge in the prior art to size the tool holder to fit the tool in the same field of endeavor for the purpose of providing a tool holder to fit a specific tool. It would have been obvious to one of ordinary skill in the art at the time the invention was made to size and shape the universal tool holder of Webb in order to hold a welding torch striker.

In rejecting claim 2, the Examiner argues:

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to make the universal tool holder of Webb by "the sleeve is formed of a single sheet of material folded to produce a fold and first and second open edges, the first and second open edges attached by stitching" (claim 2, L: 1-3). One of ordinary skill in the art would have expected Applicant's invention to perform equally well since it is "relatively inexpensive to manufacture" (C: 3, L: 35) because "of its integral, one piece design" (C: 3, L: 36). Therefore, it would have been an obvious matter of design choice to modify Webb to obtain the invention as specified in claim 2. Furthermore, Applicant has not disclosed that "the sleeve is formed of a single sheet of material folded to produce a fold and first and second open edges, the first and second open edges attached by stitching" (claim 2, L: 1-3) provides an advantage, is used for a particular purpose, or solves a stated problem.

In rejecting claim 4, the Examiner argues:

Regarding claim 4 it is the Examiner's position that the bend at the proximal end of the striker protrudes beyond the proximal end of the sleeve.

In rejecting claim 5, the Examiner argues:

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Webb (5,501,382) as applied to claim 1 above, and further in view of C.T. Manz (3,239,057). Webb does not disclose a pouch attached to the sleeve. C.T. Manz teaches the use of a pouch integral with a larger pouch in the analogous art of welding equipment holders for the purpose of holding short rod stubs. It would have been obvious to one of ordinary skill in the art at the time the invention was made to put a pouch on the universal tool holder of Webb in order to "to provide a novel stub holding pouch ... which can be easily and effectively used by the welder to deposit the short ends or stubs of welding rod" (C: 1, L: 21-24).

Applicants present below an analysis in accordance with the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), including determining the scope and contents of the prior art, and ascertaining the differences between the prior art and the claims at issue.

#### Claims at issue

Independent claims 1, 19 and 32, as currently amended, are all directed to a novel "safety stopper" for use with a "welding torch striker". The safety stopper is the novel sub-combination or element of the combination "welding torch striker with safety stopper". Independent claim 31 is directed to the combination "welding torch striker with safety stopper". See 806.05(a): "Combination and Sub-combination".

Independent claims 1, 19, 31, and 32, as currently amended, all require that the safety stopper be "adapted for attachment to the striker", either directly as in independent claims 19 and 31, or indirectly by "retention on the arms by spring force" as in independent claim 1, or indirectly by "retention on the arms by enclosing a central portion of both arms" as in claim 32.

Independent claims 1, 19, 31, and 32, as currently amended, all require that the safety stopper be "sized" and "shaped" "such that the safety stopper allows manual operation of the striker while the safety stopper is attached to the striker".

Independent claims 1, 19, 31, and 32, as currently amended, all require that the safety stopper be "sized" and "shaped" "such that the safety stopper reduces the chances of the operator being thrown off balance by the striker catching on an external object when the striker, with the safety stopper attached, is carried hands-free attached to an operator's belt".

### **Scope and Contents of the Prior Art**

The striker is prior art. The use of a striker is illustrated in FIG. 6 (prior art) of the application as filed. FIG. 6 shows striker 40 hanging from spring latch 29, spring latch 29 hanging from hammer strap 55, and hammer strap 55 hanging from the construction worker's belt 56.

The Examiner cites US Patent No. 5,501,382 to Webb. As noted by the Examiner:

Webb discloses a universal hand tool holder a sleeve 110 made of "leather" (C: 3, L: 32), means (224A, 2246) for attaching holder to a belt, and "Although the preferred embodiment tool holder 100 is designed to be relatively universal in its application, each of a set of holsters may be customized somewhat to better accommodate a particular tool" (C: 6, L: 8-11).

The Examiner admits that "Webb does not disclose the tool holder specifically used for a welding torch striker", but asserts that "It is common knowledge in the prior art to size the tool holder to fit the tool in the same field of endeavor for the purpose of providing a tool holder to fit a specific tool".

The Examiner cites US Patent No. 3,239,057 to Manz. As noted by the Examiner:

C.T. Manz teaches the use of a pouch integral with a larger pouch in the analogous art of welding equipment holders for the purpose of holding short rod stubs.

### Differences between the Prior Art and the Claims at Issue

Independent claims 1, 19 and 32 are all directed to a novel "safety stopper". Independent claim 31 is directed to the combination of "welding torch striker with safety stopper".

The safety stopper of the present invention, when in use, is attached to the striker. In the prior art, as shown in FIG. 6 (prior art), welding torch striker 40 is carried hanging from a construction worker's belt for operating convenience. FIG. 6 shows striker 40 hanging from spring latch 29, spring latch 29 hanging from hammer strap 55, and hammer strap 55 hanging from construction worker's belt 56. FIG. 5 shows safety stopper 20 of the first embodiment attached to striker 40. The safety stopper is attached to, or is adapted for attachment to, the striker in every embodiment as claimed. In use, the safety stopper is attached to the striker. The safety stopper does not carry the striker.

In contrast, Webb discloses a tool holder in which the operator's belt carries the tool holder, and the tool holder carries the tool. Web does not mention a welding torch striker, or provide any reason why a welding torch striker should be carried in a holster.

The function of a holster and the function of the novel safety stopper of the present invention differ in significant respects:

- 1) A holster is adapted for carrying something. In contrast, the safety stopper of the present invention carries nothing.
- 2) A holster is customarily adapted for attachment to an operator's belt. In contrast, the safety stopper of the present invention is adapted for attachment to a welding torch striker.
- 3) A holster customarily contains a tool, and the tool is separated from the holster while the tool is in use. In contrast, the safety stopper of the present invention remains attached to the striker while the striker is in use.



4) A holster customarily contains a tool while the tool is not in use. In contrast, the safety stopper of the present invention "allows manual operation of the striker while the safety stopper is attached to the striker", i.e. while the striker is in use.

5) The purpose of a holster is to contain a tool while the tool is not in use. In contrast, the purpose of the safety stopper of the present invention is to reduce "the chances of the operator being thrown off balance by the striker catching on an external object".

The Examiner's assertion that "It would have been obvious to one of ordinary skill in the art at the time the invention was made to size and shape the universal tool holder of Webb in order to hold a welding torch striker" is not applicable to the present invention because the purpose of the present invention is not "to hold" anything, but to reduce "the chances of the operator being thrown off balance by the striker catching on an external object". There is no mention of this motivation in the prior art cited by the Examiner.

The Examiner's new *prima facie* arguments are therefore incomplete and defective because they do not address any of the above-listed differences and, absent proper motivation, the Examiner's suggestion to "size and shape the universal tool holder of Webb in order to hold a welding torch striker" would not alone make the safety stopper of the present invention, as claimed.

Accordingly, the Examiner's rejection of pending independent claims 1, 31, and 32 under 35 U.S.C. 103(a) as being unpatentable over Webb (5,501,382) should be withdrawn, and pending independent claims 1, 31, and 32 should be passed to allowance. Claims 2-5 all depend from claim 1, so when claim 1 is passed to allowance, claims 2-5 should also be passed to allowance. Claims 33-37 all depend from claim 32, so when claim 32 is passed to allowance, claims 33-37 should also be passed to allowance.

#### **Request for Rejoinder and Allowance of Non-Elected Claims**

The Examiner imposed a restriction requirement to species 1, and withdrew claims 6-30 and 33-37 from consideration as being drawn to non-elected species 2-9. In the listing of claims above, the status of each of claims 6-30 and 33-37 is marked "withdrawn".

**Request for Rejoinder and Allowance of Dependent Claim 6**

When claim 1 is passed to issue, applicant respectfully requests rejoinder of claim 6. Although withdrawn by the Examiner, claim 6 depends from claim 1, so when claim 1 is passed to allowance, claim 6 should be rejoined and passed to allowance. Applicant respectfully requests that claim 6 be rejoined and passed to allowance.

**Request for Rejoinder and Allowance of Independent Claim 19**

Claim 31 is a combination claim directed to a "welding torch striker with safety stopper". Claim 19 is a sub-combination claims directed to a "safety stopper".

As noted above, claims 19 and 31 are amended so that both claims use the same wording to define "safety stopper". This ensures that the combination of claim 31, as claimed, requires the particulars of the sub-combination of claim 19, as claimed, for patentability, so claims 19 and 31 are not patentably distinct. This makes sub-combination claim 19 eligible for examination when combination claim 31 is found allowable. See 806.05(a): "Combination and Sub-combination".

Furthermore, when claim 31 is passed to allowance, claim 19 should also be passed to allowance because both claims rely on the novelty of the safety stopper alone, which has already been established as a basis for allowance of claim 31.

**Request for Rejoinder and Allowance of Dependent Claims 8-18**

When claim 19 is passed to allowance, applicant respectfully requests rejoinder of claims 7-18. Although withdrawn by the Examiner, all of claims 7-18, as currently amended, ultimately depend from claim 19, so when claim 19 is passed to allowance, claims 7-18 should be rejoined and passed to allowance. Applicant respectfully requests that claims 7-18 be rejoined and passed to allowance.

**Request for Rejoinder and Allowance of Dependent Claims 22-29**

When claim 31 is passed to allowance, applicant respectfully requests rejoinder of claims 22-29. Although withdrawn by the Examiner, all of claims 22-29, as currently amended, ultimately depend from claim 31, so when claim 31 is passed to allowance, claims 22-29 should be rejoined and passed to allowance. Applicant respectfully requests that claims 22-29 be rejoined and passed to allowance.

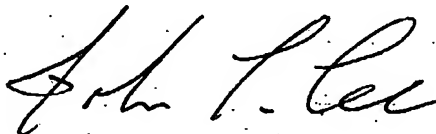
**Remarks re: Examiner's Objection to the Drawings**

The Examiner objected to the drawings under 37 CFR 1. 83(a) based on the wording of claim 20. Applicant has not requested herein rejoinder of claim 20. Accordingly, claim 20 remains with drawn. A response to the Examiner's objection to the drawings will be provided if and when a continuing application is filed directed to the subject matter of claim 20.

**Summary**

It is believed that no extension of time is required. If additional fees are required for the timely consideration of this application, please charge deposit account no. 120914.

Respectfully submitted,



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